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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/425,234	10/25/1999	HAMID RABIE	4320-91	9266
1059	7590	02/17/2004	EXAMINER	
BERESKIN AND PARR SCOTIA PLAZA 40 KING STREET WEST-SUITE 4000 BOX 401 TORONTO, ON M5H 3Y2 CANADA			MENON, KRISHNAN S	
			ART UNIT	PAPER NUMBER
			1723	
DATE MAILED: 02/17/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/425,234	RABIE ET AL. <i>ab</i>
	Examiner Krishnan S Menon	Art Unit 1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 January 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 and 27-38 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-17 and 27-38 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

This is a first action on an RCE with claims 1-17 and 27-38 pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 and 27-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (US 5,403,479) in view of applicant's admission of known prior art.

Claim 1: Smith teaches a method of cleaning membranes immersed in water (abstract, figures) comprising performing one or more cleaning events per week (Fig 4,6) having steps of stopping permeation, flowing a chemical cleaner through the membrane in the reverse direction of permeate flow, resuming permeation, with the weekly CT being between 2000 and 30,000 min.mg/L (table line 9: 100 ppm (NaOCl) * 60 min = 6000 min.mg/L; col 11 line 30-35: duration about 1 Hr; col 15 lines 34-36: concn. At 10 ppm), wherein the cleaning events reduce the rate of decline of the membrane permeability (col 11 line 20 – col 13 line 5).

Smith does not teach the definition of CT as in claim 1(c)(i). However, this is only a mathematical expression of the measure of concentration of the cleaning solution,

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times the duration of cleaning cycle, for the convenience of the inventors, and is not a patentable limitation.

Smith teaches about performing recovery cleaning by the prior art methods in "Background of the Invention". More importantly, Smith teaches the first cleaning (or, the intensive recovery cleaning) as defined by the applicant in the specification (page 3 second para, referencing US 5,403,479, in col 19 lines 27-30). Smith also teaches the method of back-flushing with a cleaning solution, or the "in-situ cleaning", which is like the "cleaning events". In addition, Smith teaches "cleaning events" having varying degrees of intensity as best exemplified in fig 4. (see smith figures, abstract, col 11 line 22 – col 12 line 25, col 19 lines 5-47). Smith also teaches a method of infrequent harsh cleaning with more frequent back-flushing in lines 18-30, col 9.

What Smith does not specifically teach is performing the "first cleaning" from time to time, with more frequent "event cleaning" in between, as in claim 1, in that particular format. Applicants' own admission of 'known process for cleaning membranes' teaches these steps in the specification pages 1-3 (Background of the Invention), especially page 2 lines 6-7. It would be obvious to one of ordinary skill in the art at the time of invention to modify the methods taught by Smith with the 'known process' of cleaning the membrane as taught by the admission of prior art by the applicant for more effective cleaning. Smith provides sufficient disclosure for the first cleaning in the form of methods taught by prior arts and his own inventions. One skilled in the art could pick cleaning methods of varying intensity just from Smith's own inventions, because the

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disclosure of the first cleaning, or the “intensive/recovery cleaning, provided by the applicant is from Smith’s invention (see specification page 3 lines 7-14).

Claims 2-4: Smith teaches processing waste water (abstract), and ground water (col 20 lines 35-40) which is well known for drinking. Re the CT values, in these claims, it is only a result effective variable optimizable depending on the feed water quality, quantity, and the process flow rate. Discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980); *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); *In re Aller*, 42 CCPA 824, 220 F.2d 454, 105 USPQ 233 (1955). (See also Smith col 19 lines 5-13)

Claims 5 adds additional limitations of pulsed flow for the chemical cleaner and a wait period with the pump off for the chemical cleaner to ‘clean’. Smith teaches pulsed flow (col 11 lines 35-50), and the need for soak periods (col 14 lines 55-68), or blocking the flow of solution in col 12 line 68 – col 13 line 5, and the details and the need for of pulsing in col 16 line 60 – col 17 line 6. One of skill in the art could optimize the length of pulse and wait periods depending on the nature of water treated (*In re Boesch*).

Claim 6 adds the more intensive cleaning as being 15 days apart, which is a result effective variable (*In re Boesch...*)

Claims 7-10: the weekly CT values are result effective variables as discussed in claims 2-4 above.

Claims 11-12: the time duration of the pulse and wait are, again, result effective variable (*In re Boesch..*)

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Claim 13: pulses selected to provide chemical cleaner in an area adjacent the membrane: see Smith abstract re the fouling film formed on the outside surface of the membrane, and col 14 lines 33-68 re effect of the cleaning solution on the fouling biofilm.

Claim 14: the pulsing pressure is in the range as in claim 14, since Smith uses min 100 kPa *absolute* pressure (Smith says this as 1 bar or at least 0.1psig, which means the 100kPa is absolute pressure). Since 5 – 55 kPa is above the pressure on the outside of the membrane (which at least would be one atm, or about 1 bar), the pressures are within the same range.

Claim 15: the flow rate of the membrane should be inherently the same in Smith, since Smith uses similar membranes (UF or microfiltration – see abstract). Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986)

Claims 16 and 17: removing chemical cleaning before resuming permeation – see col 12 lines 64-66: withdrawing the electrolyte (chemical cleaner) from the lumen before reestablishing normal operation.

Claim 27: all the limitations of claim 27 are already discussed in claims 5-7, except the chemical cleaner concentration between 20 and 200 mg/L and the time

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period of 10-100 min. Smith teaches these in col 11 lines 32-35 and the table in col 15 at line 9.

Claims 28-30: CT values – result effective variable (In re Boesch)

Claim 31: Smith teaches the membrane as immersed in water, outside of the membrane is in contact with water containing solids and there is no agitation (see abstract; col 1 lines 33-66 and col 2 lines 62-65).

Claim 32: see rejection of claim 6

Claim 33: the performance recovery in the membrane by the cleaning is at least to 70% of the initial flux in Smith (see abstract).

Claim 34: the membrane is hollow fiber (col 15 lines 48-62).

Claim 35: Smith does not teach any agitation.

Claim 36: Flowing chemical cleaner by introducing chemical cleaner to the flowing water – see figures. Smith provides cleaning chemical in a tank which is flowed through the system, in water, which is equivalent to what is claimed.

Claim 37: cleaning at regular intervals and each having the same CT: optimizing a result effective variable, In re Boesch...

Claim 38: replacing some or all of the water in the tank with fresh feed water after step (B)(b): since the step after step (B)(b) of claim 1 is resuming permeation, one would be constantly replacing the water in the tank to replace the water taken out in the permeate. Smith teaches that by his method, draining the tank becomes unnecessary (col 11 lines 50-60) because the amount of cleaning chemical discharged in to the tank is insignificant compared to the volume of the tank. However, if reducing the level of

cleaning chemicals introduced into the water becomes necessary, one of ordinary skill in the art would obviously drain the tank.

Response to Arguments

Applicant's arguments filed 6/11/03 have been fully considered but they are not persuasive.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Argument re the CT parameter: The 'CT' parameter is only a mathematical expression of concentration of cleaning solution, times the duration of cleaning. This parameter does not necessarily provide a true measure of the efficacy of cleaning because it has no dependency on the membrane area to be cleaned, and the quantity, quality and types of contaminants of raw water processed before the cleaning. One of ordinary skill in the art would know that the degree of fouling of the membrane is dependent on these factors, and the concentration and length of cleaning would depend on the degree of fouling of the membrane. Re whether the Smith methods relate to the cleaning events between the recovery cleanings, it may be noted that all the cleanings are for the reason of recovering the lost membrane performance. Smith teaches all the methods of cleaning as claimed in the instant claims. The deficiencies in the Smith reference are clearly overcome in the rejection.

Arguments re the Celeritas doctrine: This argument is moot, since the non-final rejection clearly indicated passages in the Smith reference that taught "recovery/intensive cleaning" as used by the applicant, and which is again reiterated in this rejection. Even though reference has been made in the rejection on passages that Smith taught in the "Background of the Invention", there is enough teaching in Smith reference for methods that can be used as first cleaning and event cleaning, as is used by the applicant. In fact, the applicant's method of cleaning seems to be a direct outcome of the fig 4 of Smith reference, put into an optimized procedural packet. Claims do not recite what the "first cleaning" entails, other than that it is more intensive than the event cleaning. The specification teaches the intensive cleaning as what is taught by the Smith ref, which is in-situ back-flushing with cleaning chemicals. The event cleanings are also described by the claims as back-flushing with cleaning chemicals (albeit less intensity).

Argument re the pulsing is discussed in the rejection.

Applicant's argument re the application of In re Boesch in claim 6: Applicant argues that the first cleaning and event cleaning are not known in the Art, which is not true, because the applicant admits prior knowledge (page 2 of spec)

Re claims 16 and 17: applicant argues that the Smith ref does not teach removing the chemical cleaner from the tank as retentate because Smith teaches against draining the tank. See above paragraphs for the response.

Re claim 33: The cleaning steps used is similar to that in Smith, Smith teaches at least 70% recovery of flux, therefore, it reads into the claim.

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Re claims 34 and 35, that Smith does not stop air flow (agitation): the referenced paragraph describes only the normal operation of the system of Fig 2 in Smith. Smith teaches that air is provided for maintaining the bacteria, and does not teach that it is for the explicit purpose of agitation. Smith also does not teach anywhere to keep the system agitated during the cleaning procedure he teaches under the summary of the invention.

Rest of the arguments are addressed in the rejection or in the above paragraphs.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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